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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,148	10/14/2003	Minoru Kawahara	450100-04787	4785
7590 04/04/2008 FROMMERM LAWRENCE & HAUG LLP 745 FIFTH AVENUE NEW YORK, NY 10151			EXAMINER SHIBRU, HELEN	
		ART UNIT 2621	PAPER NUMBER	
			MAIL DATE 04/04/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/685,148	KAWAHARA, MINORU
	<b>Examiner</b>	<b>Art Unit</b>
	HELEN SHIBRU	2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 December 2007.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-30 is/are pending in the application.  
 4a) Of the above claim(s) 8,10,18,20,28 and 30 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7,9,11-17,19,21-27, and 29 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Response to Amendment***

1. The amendments, filed 12/12/2007, have been entered and made of record. Claim 8 was withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species as stated on the Office Action mailed on 09/13/2007. Claims 1-7, 11-17, 19, 21-27 and 29 are pending.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1-7, 9, 11-17, 19, 21-27 and 29 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9, 11-17, and 19 are rejected under 35 U.S.C. 103(a) as being obvious over Ishige (US PG PUB 2002/0057894 A1) in view of Kellner (WO 94/03851).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter

disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Ishige discloses a data processing apparatus comprising: a detector for detecting completion of preparations (editing) for outputting first data read from a data recording medium which stores said first data and second data corresponding to said first data and having a data amount smaller than that of said first data (see fig. 1 where it shows encoders of low and high resolution data and claim 1 and paragraphs 0025-0029); and a selector for selectively outputting said second data read from said data recording medium until the completion of said preparations for outputting said first data is detected, said selector further outputting selectively said first data once the completion of said preparations for outputting said first data is detected (see paragraphs 0037-0044).

Claim 1 differs from Ishige in that the claim further requires a ready flag that denotes a status of the preparations.

In the same field of endeavor Kellner discloses a ready flag that denotes a status of the preparations (see page 5 paragraph 3 and page 6 paragraph 2, if, while the system is reading elements, the buffer becomes full, this is detected in step 208 and the reading process pauses). Therefore in light of the teaching in Kellner it would have been obvious to one of ordinary skill

in the art at the time the invention was made to modify Ishige by providing a status indicator in order to place all the data in the buffer.

Regarding claim 2, Ishige discloses a first controller for controlling reproduction of said first data; and a second controller for controlling reproduction of said second data; wherein said first controller controls the reproduction of said first data in response to the reproduction of said second data controlled by said second controller (see fig. 1 and paragraphs 0027-0028).

Regarding claim 3, Ishige discloses first data and said second data corresponding to said first data are stored intermittently on said data recording medium (see paragraphs 0036 and 0041).

Regarding claim 4, Ishigie discloses first data are video data and said second data are video data obtained by lowering resolution of the video data constituting said first data (see abstract).

Regarding claim 5, Ishige discloses a resizer for resizing the video data constituting said second data into the same size as that of said first data (see paragraphs 0026-0028).

Regarding claim 6, Ishige discloses a decoder for decoding said first data furnished as encoded data; wherein said detector detects completion of preparations for outputting results of the decoding performed by said decoder (see paragraphs 0041-0044).

Regarding claim 7, Ishige discloses a reader for reading said first data and said second data from said data recording medium (see fig. 1 components 3 and 4).

Regarding claim 9, Ishige discloses first data are made up of a continuous collection of clips, said first data being reproduced on a clip by clip basis, said data processing apparatus further comprising: a position calculator for calculating a current clip read ending position and a

next clip read starting position, said current clip read ending position being the position in which to end reading of the currently reproduced clip from said data recording medium, said next clip read starting position being the position from which to start reading from said data recording medium the clip to be reproduced next following the current clip; and wherein said reader stops reading of the current clip from said data recording medium in said current clip read ending position and starts the reading of the next clip from said next clip read starting position (see paragraphs 0041-0044 and claims 1-9).

Method claims 11-17 and 19 are rejected for the same reasons as discussed in claims 1-7 and 9 above.

5. Claims 21-27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishige in view of Kellner and further in view of Official Notice.

Regarding claim 21-27 and 29, the limitations in claims 21-27 and 29 can be found in the apparatus claim 1-7 and 9 respectively. However claims 21-27 and 29 further require a program to perform steps as claimed in claims 1-7 and 9. Official notice is taken that it is well known in the art to embody inventions in software to be executed by a computer. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teaching of Ishige and Kellner by having a software program to execute the steps of the method claim. The motivation for having a recordable by a computer is that such a method can be easily enhanced and executed multiple times.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 21-27 and 29 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. *Warmerdam*, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. In addition a mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship either as part of the stored data or as part of the computing processes performed by the computer then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer, and therefore are not statutory. See MPEP 2106.IV.B.1.

*Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571)272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HELEN SHIBRU/  
Examiner, Art Unit 2621  
March 18, 2008

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621